

REMARKS

This response is a full and complete response to the Office Action, mailed July 9, 2009. Reconsideration of the above-referenced patent application in light of the following remarks and foregoing amendment is respectfully requested.

In the present Office Action, Claims 4 – 16, 18 – 35, 37, 41 – 42, 52 – 59, 61, 63, 72 – 129, 134 - 169 are pending. Of these claims, all claims have been amended except for claims 34, 42, 58 and 82; however, the foregoing amendment of claims 5-9, 11-16, 19-22, 24-25, 27-29, 31-35, 53-55, 57, 61, 63, 73-81, 84-87, 89-90, 92-94, 96-97, 99-127, and 134-169 is not intended to narrow claim scope and should not result in any prosecution history estoppels. The amendments to this latter list of claims merely address formal matters and do not affect claim scope. It is also noted that no claims have been cancelled or added.

The Examiner has objected to claims 10, 76, and 95 citing minor informalities of grammar. These claims have been amended to address the Examiners objection. Again, the minor amendment of these two claims does not alter claim scope and, therefore, no prosecution history estoppel results. It is respectfully requested that the objection to these claims be withdrawn.

In the Action, the Examiner has rejected Claims 23 - 25, 112 - 115, under 35 U.S.C 101. However, these claims have been amended. Assignee respectfully asserts that as amended these claims meet section 101. For example, Assignee directs the Examiner to page 6 of the recently released interim guidelines. It is therefore respectfully requested that the rejection of these claims be withdrawn.

In the Action, the Examiner has rejected Claims 4 – 16, 18 – 35, 37, 41 – 42, 52 – 59, 61, 63, 72 – 78, 79 – 129 and 134 – 169 under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (US 2002/0056118) in view of Weaver, III, et al. (US 2002/0015496). As discussed below, a variety of the rejected claims have been amended.

The Examiner is reminded that to successfully make a *prima facie* rejection under 35 USC § 103, the Examiner must show that Assignee's claimed subject matter would have been obvious to one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See, KSR International, Co. v. Teleflex, Inc., US Supreme Court (decided April 30, 2007). Some of the factors to consider in this analysis include the differences between the applied documents and Assignee's claimed subject matter, along with the level of skill associated with one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. One way in which an Examiner may establish a *prima facie* case of unpatentability under 35 USC § 103 would be to show that three basic criteria have been met. First, the Examiner should show that the applied documents, alone or in combination, disclose or suggest every element of Assignee's claimed subject matter. Second, the Examiner should show that there is a reasonable expectation of success from the proposed combination. Finally, the Examiner should show that there was some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art pertinent to the claimed subject matter at the relevant time, to modify the document(s) or to combine document teachings. The motivation or suggestion to make the proposed combination and the reasonable expectation of success should be found in the prior art, and should not be based on Assignee's disclosure. See, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); See, MPEP § 2142; 2143 - § 2143.03 (regarding decisions pertinent to each of these criteria). It is respectfully asserted that the Examiner has not met these standards.

Furthermore, on October 10, 2007, the USPTO published in the Federal Register its Examination Guidelines under 35 USC § 103 in view of the KSR decision, cited above. These guidelines contain a number of relevant points. In particular, the new Guidelines state that an Examiner must articulate a reason or rationale to support an obviousness

rejection. Specifically, Examiner's must articulate findings as to the scope and content of the prior art to support the obviousness rejection being made. The Examiner should focus on the state of the art and not on impermissible hindsight (e.g., from inappropriate use of Assignee's disclosure). Specifically, Examiners need to account for all claim limitations in the rejections, either by indicating how each limitation is shown by the applied documents or by providing an explanation of how the document is legally relevant despite the limitation not being shown. Thus, Examiners must explain reasoning that provides a nexus between the factual findings and the legal conclusions of obviousness. It is respectfully asserted that the Examiner has not met these standards.

Even under the PTO guidelines released after the KSR decision, the Examiner should still demonstrate that each and every element of the rejected claims is shown by the applied documents.

As noted previously, a variety of claims have been amended. Assignee respectfully asserts that the rejected claims, as amended, are patently distinguished from any combination of the applied document, due, at least in part, to the novel method of broadcasting and coding of media content. The foregoing amendments of these claims is supported throughout the specification, for example, at paragraph [0008] paragraph [0011], paragraph [0012], paragraph [0014], and paragraph [0042], to provide several examples. Therefore, no new matter is added.

Assignee respectfully asserts that Hunter does not demonstrate, as previously discussed, every aspect of the rejected claims 4 – 16, 18 – 35, 37, 41 – 42, 52 – 59, 61, 63, 72 – 78, 79 – 129 and 134 – 169, as amended. Therefore, assuming, strictly for the sake of argument, that the asserted combination of applied documents were proper, which is not conceded, still the combination would fail to provide the elements of the rejected claims, as amended. Specifically, Hunter does not show or describe a method for encoding data using forward error correcting (FEC) codes onto standard television signals and transmitting the encoded data using existing television transmitters and broadcast towers resulting in media content being made available to a user at a set-top box. Hunter in

combination with any of the documents cited or applied by the Examiner fails to cure this deficiency of Hunter. Therefore, again, the combination fails to provide every element of the rejected claims 4 – 16, 18 – 35, 37, 41 – 42, 52 – 59, 61, 63, 72 – 78, 79 – 129 and 134 – 169, as amended. It is, therefore, respectfully requested that this ground of rejection be withdrawn. It is likewise respectfully requested that the claims, as amended, be permitted to proceed to issuance without delay because all of the Examiner's objections and rejections have been addressed.

Failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. It is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is not necessary to respond to every position taken by the Examiner with which Assignee does not agree in this or other correspondence. Instead, it is believed that the foregoing addresses the issues raised by the Examiner and that the present claims are in condition for allowance.

CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed July 9, 2009. In view of the foregoing amendment and remarks, Assignee respectfully submits that all pending claims, as amended, are in condition for allowance and a notification of such allowance is respectfully requested.

If the Examiner believes that there are any remaining informalities that can be corrected by an Examiner's amendment, a telephone call to the undersigned at 503.439.6500 is respectfully solicited.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3130.

Respectfully submitted,

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By

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